



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,928	09/29/2003	Rudolph Nobis	END 5209	1638

27777 7590 07/28/2005
PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

GIBSON, ROY DEAN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/673,928	NOBIS ET AL.	
	Examiner	Art Unit	
	Roy D. Gibson	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 5-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) 3, 4, 9 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 121703, 216&32505
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Houser (6,872,204).

As to claims 1, 7 and 8, Houser discloses a medical apparatus comprising:

an overtube (catheter 20 with wall 30) capable of receiving an endoscope through the lumen (64 with an open end) therein, the overtube comprising a side opening (window 28) for receiving tissue therethrough; and

a tissue sample device [cartridge 32 with cutter edge and wire (80) adapted to receive RF energy for cutting tissue], wherein the tissue cutter is adapted to transverse a length of the side opening for severing a tissue sample from tissue extending into the side opening (col. 4. line 56-col. 6, line 60).

As to claim 2, Houser further discloses the sample device comprises a tissue stop (Figure 3, inner wall of compartment 72) disposed inwardly of the side opening (col. 5, line 62-col. 6, line 6).

Claim Rejections - 35 U.S.C. § 103

Art Unit: 3739

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houser in view of Adams (6,632,227). Houser discloses an optional vacuum means for removing severed tissue to allow cutting and removal of tissue at several locations during a single procedure (col. 3, lines 28-32). However, the details of the vacuum means are not shown or described. But, Adams discloses a resection device for an endoscope (Figure 4a) wherein the tissue stop in the tip comprises a plurality of vacuum openings for drawing tissue into the side opening and inherently for removing tissue fragments (col. 5, lines 26-40). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to look to the disclosure of Adams to provide the details of a vacuum means for the apparatus of Houser - - to draw the tissue into the side opening as an alternative equivalent means to providing a balloon opposite the side opening to force the apparatus over the tissue to be severed as detailed in col. 6, line 61-col. 7, line 6, and inherently remove tissue fragments.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Houser. Houser discloses a method of obtaining a tissue sample essentially as claimed except for providing an endoscope because the method disclosed was for removing a lesion in a coronary artery, wherein the cutting device is positioned via a guidewire. However, the

Art Unit: 3739

examiner maintains that it would have been obvious to a skillful artisan to position the cutting device in other body lumens of greater diameter, such as in the gastro-intestinal tract or colon, by providing an endoscope through the lumen (64) in place of a guidewire.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houser in view of Adams (see the modified structure of the Houser device as applied to claims 5 and 6 above, and with this structure, the step of acquiring tissue would obviously be by drawing the tissue into the side opening with the vacuum). Furthermore, an endoscope could be provided to position the cutting device at the desired location, as taught by Adams, and the vacuum source communicated from a source through the endoscope, as further taught by Adams (see Figure 4).

Allowable Subject Matter


Claims 3, 4, 9 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on M-F, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Roy D. Gibson
Primary Examiner
Art Unit 3739

July 25, 2005